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**MAILED**

**JUN 09 2010**

**OFFICE OF PETITIONS**

In re Application of :  
Chen, et al. : **DECISION ON PETITION UNDER**  
Application No. 10/502,420 : **37 CFR 1.182; 1.78(a)(3); and, (a)(6)**  
Filed: August 26, 2005 :  
Attorney Docket No. 27763-705.831 :

This is a decision on the petition to expedite, filed May 18, 2010, under 37 CFR 1.182, and the petition under 37 CFR 1.78(a)(3) and (a)(6), filed March 3, 2010, to accept an unintentionally delayed claim under 35 U.S.C. § 365(c) for the benefit of priority to a prior-filed international application designating the United States of America (Application No. PCT/US03/03006, filed August 14, 2003) and priority to the prior-filed provisional applications (Application Nos. 60/353,176 and 60/421,772) set forth in the amendment filed August 20, 2009.

**DECISION UNDER 37 CFR 1.182**

In general, the Office of Petitions reviews petitions and renders decisions on petitions in the order by which the petitions are filed. Consideration outside the general course of action requires a petition to expedite (and fee). As petitioners have met the minimum requirements for expedited treatment, the petition to expedite is grantable.

In view thereof, the petition to expedite under 37 CFR 1.182 is hereby **GRANTED**.

**DECISION UNDER 37 CFR 1.78(a)(3) and (a)(6)**

As noted in MPEP 1893.03(c)(III), a national stage application filed under 35 U.S.C. § 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application. *See also* MPEP 1893.03(b). In this regard, since the international application is not an earlier application (it has the same filing date as the national stage), a priority claim in the national stage of the international application is inappropriate. Accordingly, it is not necessary for the applicant to amend the first sentence of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage under 35 U.S.C. § 371.

Accordingly, the petition under 37 CFR 1.78(a)(3) is **DISMISSED AS MOOT**.

Petitioners argue that because the Office recognized the claim for priority, a petition under 37 CFR 1.78 is unnecessary.

Where a claim for priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). On the other hand, if the USPTO does not note the claim for priority to the prior-filed applications set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6).<sup>1</sup>

In the present case, the application as filed did not include a reference to the prior-filed applications in either a currently transmittal letter or oath or declaration.

Accordingly, the Office did not recognize the claim, despite petitioners' argument to the contrary. The instant petition under 37 CFR 1.78(a)(6) is therefore necessary.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

This pending national stage application, which has a filing date of February 3, 2003, was filed within twelve months of the filing date of the prior-filed provisional applications, Application No. 60/353,176, filed February 4, 2002, and Application No. 60/421,772, filed October 29, 2002, and for which priority is claimed. A reference to the prior-filed provisional application has been included in an amendment filed August 20, 2009 to the first sentence of the specification following the title.

However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application

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<sup>1</sup> Note MPEP 201.11 (III)(D) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 119(e) after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 119(e) is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a renewed petition under 37 CFR 1.78(a)(6) and either a Supplemental Application Data Sheet or a substitute amendment (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)) deleting the incorporation by reference statement, are required.

In view thereof, the petition under 37 CFR 1.78(a)(6) is DISMISSED.

Receipt is hereby acknowledged of the fee required by 37 CFR 1.182 and the fee required by 37 CFR 1.78(a)(6)(ii).


Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop PETITIONS  
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Any questions concerning this matter may be directed to Alesia M. Brown at (571) 272-3205.

  
Anthony Knight  
Director  
Office of Petitions